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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/050,286      | 01/16/2002  | David M. Dean        | AD6786USNA2         | 7020             |

23906 7590 11/04/2003

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| EXAMINER |
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KOPPIKAR, VIVEK D

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1775

DATE MAILED: 11/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

CLO7

**Office Action Summary**

Application No.

10/050,286

Applicant(s)

DEAN ET AL.

Examiner

Vivek D Koppikar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## FINAL OFFICE ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Claims 1-4 in Paper No. 5 is acknowledged. The traversal is on the ground that any search for prior art pertaining to the label of the present invention would necessarily find art associated with making the label including in-situ making of the label on the article. This is not found persuasive because as stated in Paper No. 5 the process of labeling the article includes a step of curing and the transparent paramagnetic label could be formed by a process which does not involve curing.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Number 06-122803 to Kozo (hereafter referred to as JP'803).

JP'803 teaches a mixture comprising a polymer and up to 35% of a rare earth element including dysprosium (element 66) (Translated Abstract). The polymer is methacrylic acid (as in the instant invention) so it is paramagnetic and transparent.

JP'803 does not recite the magnetic mass susceptibility of the mixture nor that the mixture has the property of being essentially free of optical detection by a person with 20/20

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vision from a distance of 3 feet or more. JP'803 also does not teach that the mixture has a transparency such that it is possible to transmit at least 55% of the incident radiation through a 1/8 inch thick test piece of the label material for greater than 50% of the wavelengths in the range of 400 to 1800 nanometers (nm).

However the examiner takes the position that the mixture of JP'803 has all these properties since it has the same chemical composition and similar structural limitations as the instant invention absent a showing of evidence to the contrary.

*Response to Arguments*

4. The 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection has been withdrawn. The arguments filed on September 8, 2003, as part of Paper No. 6, have overcome this rejection.

5. The provisional double-patenting rejection under 35 U.S.C. 101 has been withdrawn. The arguments filed on September 8, 2003, as part of Paper No. 6, have overcome this rejection.

6. Applicant's arguments filed on September 8, 2003 have been fully considered but they are not persuasive.

The arguments will be addressed in sequential order as they were set forth in Paper No. 6.

Applicants argue that JP'803 does not mention that paramagnetic properties can be imparted to a composition by inclusion of rare earth elements.

However the examiner takes the position that even though JP'803 does not explicitly recite that paramagnetic properties can be imparted to a composition by inclusion of rare earth elements the composition taught in JP'803 is a polymer with a rare earth content of between .001 to 35 weight percent which is similar to the instant invention. Because of this similar chemical structure the examiner takes the position that the composition taught in JP'803 exhibits

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paramagnetic properties which are imparted onto it because of the rare earth compounds present in the polymeric composition.

Applicants argue that JP'803 provides a list of rare earth elements, most of which are outside the present invention, and does not provide any suggestion or motivation to pick the ones that happen to be in the present invention.

However the examiner takes the position that one of the rare earth elements used in JP'803 is dysprosium (Translated Abstract), which is element (66), and in the instant invention using dysprosium as the rare earth element is a "particularly preferred rare earth ions" (Specification, page 6, Ln. 24-27).

Applicants argue that JP'803 provides no teaching or suggestion of using a "sufficient amount" of "specific rare earth elements" to get a "magnetic mass susceptibility of at least  $20 \times 10^{-6}$  emg/g at 298 Kelvins. Applicants go on to state that at levels of as little as 0.001 weight percent of rare earth content a polymeric composition will almost very little or no magnetic mass susceptibility.

However the examiner would like to point out that in JP'803 the rare earth content can be between .001 weight percent and 35 weight percent (Translated Abstract). In the instant specification it is implied that for a polymeric composition to exhibit magnetic mass stability it is preferable to have a rare earth content of around 9 weight percent or greater (Specification, Page 1, Ln. 14-27). The examiner takes the position that in the embodiments of JP'803 that include a rare earth composition of 9 weight percent or greater have a magnetic mass stability which is similar to the numeric value claimed in Claim 1 of the instant invention.

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The applicants finally point to one of the working examples which shows a rare earth content of only 8 weight percent which is less than the rare earth content required by claim 2 and that there is no suggestion that it would be sufficient in the final polymerized composition to obtain a magnetic mass susceptibility of at least  $20 * 10^{-6}$  emg/g at 298 Kelvins.

With regard to this argument, the examiner points out that it is specifically stated in the Translation of JP'803 that the working examples are not limiting the scope of the invention (Translation, Section [0016]). Therefore the examiner takes the position that since the specification of JP'803 discloses that the rare earth content can be as high as 35 weight percent (Translation, Claim 2) there are embodiment of JP'803 where the composition has a magnetic mass susceptibility of at least  $20 * 10^{-6}$  emg/g at 298 Kelvins since both JP'803 and the instant invention teach a polymer composition and the amount of rare earth content in both disclosures is similar, at least in some embodiments.

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-6618**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached at (703) 308-3822. The fax phone numbers for the organization where this application or proceeding are assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Vivek Koppikar

10/20/03

  
DEBORAH JONES  
SUPERVISORY PATENT EXAMINER